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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,297	12/11/2001	Michael J. Oister	43108.830003.000 (0024)	3140
7590	11/17/2003			EXAMINER
Brian P. Kinnear Holland & Hart, LLP Suite 3200 555 Seventeen Street Denver, CO 80202			NGUYEN, KIEN T	
			ART UNIT	PAPER NUMBER
			3712	(3)
			DATE MAILED: 11/17/2003	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 10/014,297

MAILED

Filing Date: December 11, 2001

NOV 14 2003

Appellant(s): OISTER ET AL.

GROUP 3700

Brian Kinnear
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/05/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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5,810,685	Willner et al.	09-1998
5,468,000	Bennett	11-1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurer U.S. Patent 5,912,864 in view of Willner et al U.S. Patent 5,810,685.

Maurer disclosed a ball (10) comprising at least one timer (20) integrated with the ball for measuring at least one time period, a display for displaying the elapsed time. The timer is mounted on the surface of the ball, and comprised a reset switch (21) as a push button, a display mounted on the surface of the ball as shown in Fig. 5, a control panel (11), a motion detector (12) integrated with the ball. It is noted that Maurer failed to teach a sound generator integrated with the ball for producing at least one sound at the end of the time period as set forth in these claims. However, Willner disclosed a ball having a sound generator (18) for producing at least one sound responsive to an acceleration sensor. Therefore, it would have been obvious to one of ordinary skill in the art to modify the ball of Maurer with the sound generator of Willner for producing the

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sound based on the time measured by the timer (20) for the purpose of allowing the users to acknowledge the measured without actually holding or looking at the ball.

Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurer as modified by Willner et al as applied to claim 1 above, and further in view of Bennett U.S. Patent 5,468,000.

It is noted that the combination of Maurer and Willner et al failed to teach a receiver with a proximity controller as set forth in these claims. However, Bennett disclosed an arrow (10) having a receiving means or receiver (12) integrated in the arrow, and a remote control (20) capable of sending signals to the receiver. Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Maurer and Willner et al with the receiver and remote control as taught by Bennett for the purpose of allowing the user to control the ball from a distance.

(11) Response to Argument

In response to appellant's argument that Maurer failed to teach "at least one timer integrated with the ball for measuring at least one predetermined time period", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, since applicant failed to recite any particular feature of

the timer to support the desired function, it is submitted that the timer of Maurer is capable of performing the stated function. Furthermore, the timer (20) of Maurer measures the ball's flight duration which could reasonably be construed as a "predetermined time period".

In response to appellant's argument that Bennett U.S. Patent 5,468,000 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is submitted that the Bennett reference is in the field of applicant's endeavor because it relates to a projectile (an arrow) which is similar to a ball.

In response to appellant's argument Bennett does not address the field and problem of the present application that is "turning on of a timer when an object comes within a predetermined distance from a target" as stated in Group II, actually claim 15 only requires the controller is "capable of sending a signal to the receiver when the ball is within a predetermined distance such that the receiver signal actuates a reset". There is no requirement from claim 15 that the controller turning on of a timer when the ball comes with a predetermined distance from a target. Accordingly, such argument is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Kien T. Nguyen
Primary Examiner
Art Unit 3712

Ktn
November 14, 2003

Conferees

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